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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,337	01/30/2004	Mark Ferraro	770P011329-US (PAR)	6516

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EXAMINER
COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Advisory Action *Before the Filing of an Appeal Brief*	Application No. 10/768,337	Applicant(s) FERRARO, MARK	
	Examiner Edward R. Cosimano	Art Unit 3639	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>15 June 2005</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

      Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ They raise the issue of new matter (see NOTE below);

   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>see attached.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.

13. ☐ Other: _____.

Edward R. Cosimano
Primary Examiner
Art Unit: 3639

1.   Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e).

2.   The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
>   (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.1   Claims 1-8 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Wright et al (4,802,218) as evidenced by inherent operation, Aldebert et al (5,794,033), see MPEP § 21310.1(III).

3.1.1   In regard to claims 1-8, Wright et al ('218) discloses a computerized postage metering system that includes programmed computer 30 and computer controlled printer 40. Under the control of a postage metering operating program that has been supplied by the manufacture and Post Office, computer 30 would use the weight of an item to be shipped as manually entered by the operator using keyboard 31 or automatically obtained from a scale 53 and postage rate data stored in a manually inserted card 90 to determine the correct amount of postage for the item being shipped. After determining the required postage for the item to be shipped, computer 30 requests an postage indicia for the required amount of postage from a manually inserted smart card 10 as evidence that the required amount of postage has been paid. Smart card 10, which contains the postage accounting information associated with the user, determines if the user has sufficient prepaid postage funds to pay for the required postage amount, and if there are sufficient funds then smart card 10 would authorize the generation of a postage indicia comprising both human readable or alphanumeric information and machine readable coded information. Where the information contained in the postage indicia that is printed in both human readable and machine readable form as taught by Wright et al ('218) would include the

required alphanumeric postage related information, in the form of date 73 and postage amount 72 and machine readable authentication information in the form of coded information 83a,83b. It is noted that as taught by Wright et al ('218) and as can be see figs. 6a and 6b, the postage indicia data used to generated the authentication information:

A) is coded or encoded using a previously obtained and stored coding method that uses an issuer, or remotely, selected encryption key and encryption program; and

B) may be printed in human readable and/or machine readable form, where the machine readable form may include a barcode or a multi-dimensional coded.

It is further noted that the smart card of Wright et al ('218) may be used to download new rate and program data into the postage metering system from a remote source.

3.1.2 In regard to the claimed communications system, since Wright et al ('218) discloses the user of various cards, that

A) contain operating programs that change the operation of the hardware with in the postage metering system of Wright et al ('218); and

B) have been provided to the user of the postage metering system of Wright et al ('218) from a location which is not the location of the user of the postage metering system of Wright et al ('218).

It would have been inherent to one of ordinary skill at the time of the invention was made that the receipt and use of the program cards received from another location in conjunction with the postage metering system of Wright et al ('218) would implement a type of communications system where the program card are the communications media.

3.1.3 It is further noted in regard to the use of the cards to update or reprogram the operating program of the system of Wright et al ('218) via a communications system, that Wright et al ('218) discloses the one or more cards used in the postage metering system of Wright et al ('218) are smart cards that contain a programmed processor and a memory containing an operating program. Where when one of these smart cards has been manually inserted into the postage metering system of Wright et al ('218) and has been properly authenticated by the postage metering system of Wright et al ('218), then the operation of the hardware with in the postage metering system of Wright et al ('218) is altered/changed since the control processor with in the

postage metering system of Wright et al ('218) would perform a different postage metering related function by executing the program stored with in the inserted smart card.

3.1.4   Finally it is noted in regard to the use of a field programmable gate array (FPGA) in claim 2, that Aldebert et al ('033) in 1998 discloses that some computer implemented devices contain an FPGA. Where the FPGA has been implemented by a processor and an associated memory that stores the processor's operating program. Aldebert et al ('033), further discloses that the operation of the FPGA, and hence the device implemented using the FPGA, may be remotely changed by using a communications system to change/reprogramming the processor's operating program stored with in the memory of the FPGA and thereby altering/changing the operation of the hardware contained with in either (1) the device that has been implemented by an FPGA or (2) the processor of the FPGA.

3.1.5   Since the operation of the postage metering system of Wright et al ('218) may be remotely changed using a communications system by changing the operating program that is stored in a programmable memory and is used to control the operation of the processor is identical to the operation of a FPGA as described in 1998 by Aldebert et al ('033), would have been inherent to one of ordinary skill at the time of the invention was made that the combination of the processor of the postage metering system of Wright et al ('218) in conjunction with the operating program that is stored with in a smart card as taught by Wright et al ('218) is a FPGA.

4.   Response to applicant's arguments.

4.1   All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

4.2   As per the 35 U.S.C. § 102 rejection;

        A) in regard to the use of the cards of Wright et al ('218) as a "communications system", it is first noted that as would be readily recognized by one of ordinary skill at the time of the invention a communications system would comprise a combination of hardware, software and data transfer links that would permit data/information to be exchanged between two or more computers. With this in mind, as is clearly disclosed in Wright et al ('218) in the paragraph located at column 18, lines 35-57; "The invention also encompasses other features ... than purchase transactions. As another security feature, the card or series of cards may be issued with encryption algorithms and/or secret

key numbers which are changed periodically, and the encryption algorithms and secret keys corresponding to cards presented for a transaction can be loaded in the terminal at the time the terminal MPU establishes an on-line connection to the central office.". The encryption keys are periodically changed by the issuer through the use of the a card or a series of cards that have been issued from a service provider or an issuer. Further, as clearly disclosed in Wright et al ('218) in the paragraph located between column 12, line 46, and column 13, line 2: "Referring to an example shown in FIGS. 6a and 6b, a conventional imprinted postmark has ... a postmark information section 83a and a check code section 83b, which is encrypted based upon one of the postmark elements. The postmark element and/or the encryption algorithm can be uniquely selected by the issuer. Even if the coded marks are printed in visible form, the encryption of a variable postmark element, such as the sender's zip code, date, or postage amount, will make copying difficult.", the encryption algorithm and/or encryption keys that are used to encrypt postage related information that is to form part of the postage indicia is selected by the issuer. And further the cards of Wright et al ('218) are used to change the operation of the postage metering system of Wright et al ('218), as is clearly disclosed in Wright et al ('218) in the paragraphs located at column 14, lines 21-60, and at column 15, lines 23-28; "The program operation of the postal waybill terminal ... block 121. The terminal is then used to print a postmark or postage label as described previously. If a valid services card is present, the terminal program displays a menu of mailing or carrier services from the services card and requests the user to select a service. The terminal MPU 30 loads the selected service program from the service card and executes it, as indicated at block 118. For ... can be verified by machine processing of the waybill.", and "The terminal can be used to program and print the waybills of other selected carriers or services by insertion of the proper user, rate and/or service cards. For convenience of the automated terminal system, it is desirable if all postal and waybill forms can be standardized to one or a limited number of form blanks.". Hence, based on the combination of one or more of the cards of Wright et al ('218) that have been inserted into the postage metering system of Wright et al ('218), the operation of the postage metering system of Wright et al ('218) would be changed. In view of the above, one of ordinary skill at the time of the invention

would have recognized that the cards of Wright et al ('218) which are used to transfer data/information from the remote location of the computers of the card issuer to the computer implemented postage metering system of Wright et al ('218) in order to change the operation of the postage metering system of Wright et al ('218) are in fact a type of communications system.

Hence, applicant's arguments are non persuasive.

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

5.1   The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (571) 273-6802.

5.2   The fax phone number for **OFFICIAL FAXES** is (703) 872-9306.

5.3   The fax phone number for **AFTER FINAL FAXES** is (703) 872-9306.

06/28/05

Edward R. Cosimano
Primary Examiner A.U. 3639